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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/141,318	08/27/98	ISOMURA	H 1046.1190/J

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EXAMINER

ENG, G

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/141,318

Applicant(s)

Isomura

Examiner

George Eng

Group Art Unit

2643



☒ Responsive to communication(s) filed on Jan 16, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1, 3-9, 12-17, 20-24, 27-31, and 34-38 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-9, 12-17, 20-24, 27-31, and 34-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Preliminary Amendment

1. This Office action is in response to the preliminary amendment filed 1/16/2001 (paper no. 8). According to page 2 of the preliminary amendment, claims 10-11, 18-19, 25-26 and 32-33 are canceled. However, it appears that claim 2 is canceled as shown in page 2. In addition, claims 32-33 should mark canceled.

Claim Objections

2. Claims 1, 3, 8, 9, 17, 24 and 31 are objected to because of the following informalities: **claim 1**, line 2, "aplurality" should be --a plurality--, line 12, "the main managing function" should be --mail managing function--; **claim 3**, line 4, delete "the electronic mail is"; **claim 8**, line 10, "the main managing apparatus" should be --the mail managing apparatus--; **claim 9**, line 11, "the electronic managing apparatus" should be --the electronic mail managing apparatus--, line 12, "the associated terminal device" should be --an associated terminal device--, and line 17, "the mail managing apparatus" should be --the electronic mail managing apparatus--; **claim 17**, lines 9-10, "the electronic managing apparatus" should be --electronic mail managing apparatus-- and line 15, "the mail managing apparatus" should be --the electronic mail managing apparatus--; **claim 24**, lines 9-10, "the electronic managing apparatus" should be --the electronic mail management-- and lines 12-13, "said terminal device" should be --said one of the plurality of terminal devices--; and **claim 31**, line 12,

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"the electronic managing apparatus" should be --the electronic mail managing apparatus--.

Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said terminal device" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US PAT. 6,092,102) in view of Wang (US PAT. 5,757,891).

Regarding claim 1, Wagner teaches an apparatus (8) with an information managing function for connecting with at least a information server (16) and a plurality of terminal devices (10, 12, 14)

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as shown in figure 1 (col. 6 lines 10-14), said apparatus comprising access means (22) for accessing to the information server (col. 6 lines 24-26), a memory (24) for storing an information download from the information server through the access means (col. 6 lines 26-29), event monitor (4) read as a mail status memory for storing each status of the information stored in the memory so as to correspond to each of the terminal devices, wherein the event monitor having a transaction log to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and transmission means (30) for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes.

Regarding claim 3, Wagner teaches the transaction log for storing a process to be applied to the information downloaded to each of the terminal devices (col. 9 lines 40-53).

Regarding claim 5, Wang teaches the telephone further comprising emergency process means for determining whether a priority is necessary (col. 9 lines 7-20).

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Regarding claim 6, Wang teaches an identifier memory for storing an identifier of a device to be connected so that it is permitted to access from the device of which the identifier coincides with the stored identifier (col. 7 line 64 through col. 8 line 12).

Regarding claim 7, Wagner teaches an information managing method in an apparatus (8) for transmitting and receiving information to and from at least an information server (16) and a plurality of terminal devices (10, 12, 14), said method comprising the steps of a reading process of reading the information in the information server (col. 6 lines 24-26), a storing process of storing the information read in the reading process (col. 6 lines 26-29), a notify process for notifying a status of the information stored in the storing process to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and a transmission process for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes.

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Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 7.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US PAT. 6,092,102) in view of Wang (US PAT. 5,757,891) as applied in claim 3 above, and further in view of Murakami et al. (US PAT. 5,590,178 hereinafter Murakami).

Regarding claim 4, the combination of Wagner and Wang differs from the claimed invention in not specifically teaching the process to be applied to the information including deleting the information and keeping the information. However, Murakami teaches an electronic mail system providing a key for deleting respective electronic mail messages (col. 10 lines 31-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Wagner and Wang in having an user interface applied to the information including deleting and keeping, as per teaching of Murakami, because it makes user friendly so that the information is capable of deleting and keeping upon user's selection.

7. Claims 9, 12-17, 20-24, 27-31 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US PAT. 6,092,102) in view of Wang (US PAT. 5,757,891) and Fuller et al. (US PAT. 5,224,156 hereinafter Fuller).

Regarding claim 9, Wagner teaches an apparatus (8) with an information managing function for connecting with at least a information server (16) and a plurality of terminal devices (10, 12, 14)

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as shown in figure 1 (col. 6 lines 10-14), said apparatus comprising access means (22) for accessing to the information server (col. 6 lines 24-26), a memory (24) for storing an information download from the information server through the access means (col. 6 lines 26-29), event monitor (4) read as a mail status memory for storing each status of the information stored in the memory so as to correspond to each of the terminal devices, wherein the event monitor having a transaction log to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and transmission means (30) for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes. Furthermore, neither Wagner nor Wang specifically teaches transmitting the information in response to an access made by the terminal device. However, Fuller teaches a method to retrieve messages in response to access made by recipient's terminal (col. 2 lines 35-68). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination

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of Wagner and Wang to transmit the information in response to an access made by the terminal device, as per teaching of Fuller, because it causes a message to be received at a reception side in a confidential manner.

Regarding claim 12, Wagner teaches specifying means for specifying how the information transmitted to the plurality of terminal devices (col. 6 lines 45-47).

Regarding claim 13, Wang discloses the e-mail apparatus comprising means for receiving electronic mail from each terminal device and for transmitting the received electronic mail to the service (figure 2).

Regarding claim 14, Wang teaches the telephone further comprising emergency process means for determining whether a priority is necessary (col. 9 lines 7-20).

Regarding claim 15, Wang teaches an identifier memory for storing an identifier of a device to be connected so that it is permitted to access from the device of which the identifier coincides with the stored identifier (col. 7 line 64 through col. 8 line 12).

Regarding claim 16, Wang teaches that the e-mail apparatus is provided in a telephone for (figure 2 and col. 6 lines 10-32).

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 9.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 12.

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Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 13.

Regarding claim 22, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 23, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 24, Wagner teaches an information managing method in an apparatus (8) for transmitting and receiving information to and from at least an information server (16) and a plurality of terminal devices (10, 12, 14), said method comprising the steps of a reading process of reading the information in the information server (col. 6 lines 24-26), a storing process of storing the information read in the reading process (col. 6 lines 26-29), a notify process for notifying a status of the information stored in the storing process to indicate whether or not the information is downloaded to each of the terminal devices (col. 8 lines 35-65 and col. 9 lines 40-53), and a transmission process for transmitting information stored in the memory to one of the terminal devices. Note while Wagner teaches the apparatus is able to process e-mail (col. 8 lines 8-12) such that the information server can be a electronic mail server and the information can be in electronic mail form. Wagner differs from the claimed invention in not specifically teaching that the apparatus is a telephone. However, Wang teaches an e-mail ready telephone (200) as shown in figure 10 for connected to a e-mail server for managing electronic mails (col. 9 line 51 through col. 10 line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention

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was made to modify the apparatus of Wagner to the telephone, as per teaching of Wang, because it provides a telephone which can easily access to and be benefited by electronic messages without required more complicate processes. Furthermore, neither Wagner nor Wang specifically teaches transmitting the information in response to an access made by the terminal device. However, Fuller teaches a method to retrieve messages in response to access made by recipient's terminal (col. 2 lines 35-68). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Wagner and Wang to transmit the information in response to an access made by the terminal device, as per teaching of Fuller, because it causes a message to be received at a reception side in a confidential manner.

Regarding claim 27, the limitations of the claim are rejected as the same reasons set forth in claim 12.

Regarding claim 28, the limitations of the claim are rejected as the same reasons set forth in claim 13.

Regarding claim 29, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 30, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 31, the limitations of the claim are rejected as the same reasons set forth in claim 9.

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Regarding claim 34, the limitations of the claim are rejected as the same reasons set forth in claim 12.

Regarding claim 35, the limitations of the claim are rejected as the same reasons set forth in claim 13.

Regarding claim 36, the limitations of the claim are rejected as the same reasons set forth in claim 14.

Regarding claim 37, the limitations of the claim are rejected as the same reasons set forth in claim 15.

Regarding claim 38, the limitations of the claim are rejected as the same reasons set forth in claim 16.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 3-9, 12-17, 20-24, 27-31 and 34-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cooper et al. (US PAT. 6,052,442) discloses an answering machine may check for E-mail messages by calling a service provider, wherein the answering machine log in, downloads, and

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stores at least a portion of E-mail messages that have been received when the service provider answers the call (abstract).

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 308-6296 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (703) 308-9555. The examiner can normally be reached on Tuesday to Friday from 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

GEORGE ENG

April 6, 2001


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600